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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,162	08/28/2001	Eric Silverberg	1951.PSA	4632

7590 06/24/2003

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/24/2003

CP

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,162

Applicant(s)

SILVERBERG ET AL.

Examiner

Christopher M. Keehan

Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

The references listed on the IDS filed 11/19/02 have been lined through as they are not foreign patent documents, but rather other references. These references have been referred to by the examiner in the IDS and accompanying PTO-892 (there was no space left on the IDS).

Claim Objections

The objection to claims 8-11 has been withdrawn due to applicant's amendments.

Claim Rejections - 35 USC § 103

The rejection of claims 1-17 under 35 U.S.C. 102(e) as being unpatentable over Samukawa et al. (6,288,148 B1) has been withdrawn in light of a new rejection.

The rejection of claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Hartmann et al. (4,087,392) has been withdrawn due to applicant's arguments.

N w Claim R jections - 35 USC § 102/103

Claims 1-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Samukawa et al (6,288,148 B1). Regarding claims 1-3, Samukawa et al. disclose a composition comprising an acrylic polymer (col.5, line 51-col.6, line 30) and rosin ester resins and terpene phenol resins that are liquid at 150°C or less to room temperature, and examples of five different tackifiers (col.6, lines 37-39) with different softening points or of different types can be used as a mixture (col.6, lines 32-44). Samukawa et al. do not appear to specifically disclose wherein at least one tackifier having a softening point of less than about 40°C is a rosin ester tackifier, and wherein at least one tackifier having a softening point of greater than about 70°C is a terpene phenolics tackifier. However, it appears this is inherently disclosed because the tackifiers of Samukawa et al. are the same as applicant's, and the same materials would inherently possess the same properties, such as softening point as claimed by applicant. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the resins of Samukawa et al. to possess the same inherent properties of softening point.

Regarding claim 4, Samukawa et al. disclose a terpene phenolic tackifier and a rosin ester tackifier (col.6, lines 32-39).

Regarding claim 5, Samukawa et al. disclose a glass transition temperature of -20°C or less, which is included in the instantly claimed range (col.5, lines 61-65).

Regarding claim 6, Samukawa et al. disclose wherein the copolymer is crosslinked using a crosslinking agent (col.8, line 62-col.9, line 3).

Regarding claims 7 and 9, Samukawa et al. disclose wherein the acrylic copolymer comprises at least one acrylate monomer containing from about 4 to about 18 carbon atoms in the alkyl group, more specifically 2-ethylhexyl acrylate (col.5, lines 55-60).

Regarding claims 8 and 11, Samukawa et al. disclose wherein the copolymer further comprises at least one carboxy functional monomer, more specifically acrylic acid (col.6, lines 10-15).

Regarding claim 10, Samukawa et al. disclose wherein the copolymer further comprises methyl acrylate (col.6, lines 1-9).

Regarding claims 12-14, Samukawa et al. disclose an article of manufacture comprising the adhesive of claim 1, more specifically a pressure sensitive adhesive tape (col.9, lines 48-52). Although Samukawa et al. do not appear to specifically disclose a label, Samukawa et al. do disclose a tape, and it is the Examiner's position that a tape can be a label, as it can serve the same purpose. Further, this appears to be an intended use limitation. The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 15-17, Samukawa et al. disclose the instantly claimed limitations (col.10, lines 18-27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan

CME

June 4, 2003

Robert A. Dawson

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700